

REMARKS

Reconsideration and removal of the grounds for rejection are respectfully requested. Claims 1-15 and 17-26, 30-32, 47 and 48 were in the application, claims 1-15 and 17 were withdrawn, claims 18 and 48 have been amended.

Claim 18 has been amended to improve the clarity and form of the claim, converting the phrase "selecting" to "configured to select" and "converting" to "configured to convert", and confirming that the input processor, output processor and transmitter are "devices", to avoid any ambiguity as to the invention being directed to apparatus components, not to people with pencils and file cabinets. No new matter is involved in this amendment.

Claim 48 has been amended to specifically include the step of "providing" an input processor device and an output processor device, with these devices configured for performing the specified steps of the applicants' method invention, again to avoid any ambiguity as to the machine aspects of the present invention.

Entry of the amendment after final is requested and is proper in accordance with MPEP 714.12, as "Any amendment that will place the application either in condition for allowance or in better form for appeal may be entered." In this case, the Examiner indicated in the rejection under 35 USC 101, first raised by the Examiner in the Final Rejection, that "The claims must be drafted to ensure the use of a computer is undeniable in the process of the invention." Consequently, the applicant has sought to amend independent claims 18 and 48, to avoid any such ambiguity, as will be discussed further below, and so entry of the amendment is proper to meet the requirement of the examiner, and at a minimum, place the application in better form for appeal by mooted the rejection under 35 USC 101.

Claims 18-26, 30-32, 47 and 48 were rejected as being directed to non-statutory subject matter.

The rejection of the above the claims is believed to be moot in view of the amendments to claims 18 and 48. (The examiner referred to claims 1 and 2 in the rejection, yet as claims 1 and 2 have been withdrawn, it is presumed that claims 18 and 48 were intended.)

Claim 18 is an apparatus claim, and so does not need to use the term "computer". The claimed invention is "an invoice routing apparatus". This apparatus includes, among other components, a database, an input processor device, an output processor device and an invoice transmitter device. These are components of the "invoice processing apparatus", and are the components necessary for practicing the invention.

A "computer", whatever that generalized term may mean, is not necessary to describe the applicants' invention, nor is it needed to create statutory subject matter, as the invention of claim 18 is by definition a "machine" claim.

As far as the "useful, tangible, concrete" results test, described in the rejection, this test was specifically overruled by the Court of Appeals for the Federal Circuit in "In re Bilski", ___ F.3d. ___ (Fed. Cir. 2008), and the proper test is the "machine or transformation" test. That decision distinguished those claims which related to a machine, which readily pass the test for proper subject matter, from those inventions where there is a "transformation". As the claims in the present application all include "machine" elements, including method claim 48, meeting the machine prong of the test, it is not necessary to discuss the transformation prong which was the subject of the decision.

Consequently, the rejection of claims 18-26, 30-32, 47 and 48 as being non-statutory is moot and should be withdrawn.

Claims 18-26, 30-32 and 48 were rejected as being obvious over U.S. Patent no. 5,708,828 to Coleman in view of either Official Notice or U.S. patent 5,557,780 to Edwards et al..

The applicant has given consideration to the examiners' comments regarding "check processing" but finds the analysis of little relevance. How a teller handles a check has little relevance to how an invoice is processed, which is the subject of the present application, and the examiner is over-generalizing in the acceptance of Official Notice of subject matter not relevant to the applicants' invention.

Besides, what one person may do with one piece of data does not immediately translate into an obvious machine for performing the task without a human. Not every action of a person can immediately, easily and predictably be performed by a machine or computer...humans' are unique in their ability to input, analyze and use data, and many attempts to mimic human processing quite frankly have had limited success.

In any event, the rejection should be based on specific findings relative to the specific claim limitations, not over-generalized findings related to different data.

For example, the Examiner describes the example of a customer providing some form of ID and perhaps a phone number. According to the Examiner, the teller would write the information on the check, verify it and then place it in a drawer for processing. According to the Examiner the static data would be the driver's license number and the dynamic data would be the phone number. However, this does not correspond to the static and dynamic data specified in amended claim 18. In particular, the phone number would not constitute "dynamic" data because it does not change. In the present invention, the dynamic data changes dynamically from invoice to invoice, as clarified in dependent claim 20. In contrast, a phone number is static and so

does not change from transaction to transaction. Moreover, the flow of data necessary to achieve the result of the present invention would be more akin to the teller taking the check, blanking out some information, changing/adding some other information, and in the process, create an intermediate check, then passing on the new check to a third party. This a teller could not do.

Claim 18 specifies also the validation of data corresponding to the received invoices when processed into the standard intermediate form before transmission to the party being invoiced. There is no corresponding step in the Examiner's Official Notice. Again, the teller cannot create a new check, the teller can only attempt to validate the identity of the person cashing the check, and then give them cash. The teller cannot create a new check or validate all the information on the check or add static or dynamic data in the creation of a new check, and so the teller activities do not lead one to the applicants invention.

With regard to cited US 5,557,780 (Edwards et al), the Examiner alleges that Edwards discloses that it is known to add static and dynamic data and to verify the data. However, despite such generalizations, it is clear that the particular claim limitation found in claim 18 and 48 are not met in Edwards.

As to specific limitations, claim 18 specifies that the input processor device is configured to:

add static data to the data corresponding to the received invoices when processed into the standard intermediate form;

add dynamic data to the data corresponding to the received invoices when processed into the standard intermediate form; and,

validate the data corresponding to the received invoices when processed into the standard intermediate form before transmission by the

transmitter device to the party being invoiced.

In the present invention, the static data is used to fill in gaps in the invoice data that may not be present in the information received from the issuer of the invoice. Thus, the invoice data received at the input may not necessarily include static data such as the name, address and tax registration information that would traditionally be pre-printed on the invoicer's own conventional paper stationery and, hence not held in their own computer system. This gives rise to a problem when data is taken from the invoicer's computer and used for electronic billing, since not all the data required for electronic invoicing will be found in the invoicer's computer.

Similarly, as to the dynamic data, some data components in the received invoice data are relationship based and the value of the data needs to take into account who has sent the data and who the receiver of the data will be. This is solved by adding appropriate dynamic data to the data corresponding to the received invoices and then processing into the standard intermediate form. The dynamic data thus varies according to the transaction in dependence on both the seller and the purchaser.

Thus, the purpose of adding the static and dynamic data in the present invention is to ensure that when converted to the standard intermediate form, all of the data necessary for the receiver of the invoice is provided in the data that is transmitted by the invoice transmitter in the final invoice to the party being invoiced. The validation of data specified in claim 18 is an overall validation of the data in the received invoices when processed into their standard intermediate form before transmission to the party being invoiced.

Coleman does not disclose a system containing the features discussed above, precisely or any other way, and thus claim 18 and the claims depending therefrom are not rendered obvious over Coleman.

Edwards does not describe or suggest this approach, and so the combination of Coleman and Edwards would not achieve the invention claimed.

Combining Coleman, Edwards and the Official Notice relative to bank teller check cashing operations does not arrive at the applicants' invention.

Moreover, there is nothing within these patents, nor the official notice, which would predictably lead one skilled in the art to the results of the applicants' invention, and so claims 18, 48 and the claims depending therefrom are not obvious over these references.

Based on the above, favorable consideration and allowance of the application are respectfully requested. However should the examiner believe that direct contact with the applicant's attorney would advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,
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